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In re Application of
KIRJAVAINEN et al
Application No.: 08/981,219
PCT No.: PCT/FI96/00359
Int. Filing Date: 20 June 1996
Priority Date: 26 June 1995
Attorney Docket No.: U 011572-4
For: AN EXTRUSION APPARATUS AND
METHOD, A TUBULAR PRODUCT, AND A
PIPE

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: DECISION ON PETITION
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This is a decision on applicants' "RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS and PETITION UNDER 37 CFR 1.181 TO CONVERT and REQUEST FOR REFUND" filed in the United States Patent and Trademark Office (USPTO) on 17 March 1999.

BACKGROUND

On 10 June 1996, applicants filed international application PCT/FI96/00359, which claimed a priority date of 26 June 1995. A copy of the earlier international application was communicated to the USPTO from the International Bureau on 16 January 1997. A Demand for international preliminary examination, in which the United States was elected, was filed on 22 January 1997, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 26 December 1997.

On 18 December 1997, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, a check for \$1,070.00; a copy of the international application; a "translation" of the international application into English (note that the term "translation" is confusing since the copy of the international application is itself in English and thus a translation into English is not required); an

authorization to charge any additional fees to counsel's Deposit Account No. 12-0425; and a preliminary amendment. This submission was identified by applicants as having attorney docket number U 011574-0 and was assigned application number 08/981,360 (the '360 application) by the United States Patent and Trademark Office (USPTO). The "translation" does not appear to be identical to the published international application. (Although the two have not been compared line by line, it is noted that at least the titles are different.)

On 19 December 1997, applicants filed another transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, a check for \$1,070.00; a copy of the international application; a "translation" of the international application into English (the term "translation" is confusing since the copy of the international application is itself in English and thus a translation into English is not required); an authorization to charge any additional fees to counsel's Deposit Account No. 12-0425; and a preliminary amendment. This submission was identified by applicants as having attorney docket number U 011572-4 and was assigned application number 08/981,219 (the '219 application) by the USPTO. The "translation" provided with this submission does not appear to be identical to either the international application or the "translation" filed 18 December 1997.

On 19 December 1997, applicants also filed another transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, a copy of the international application; a "translation" of the international application into English (the term "translation" is confusing since the copy of the international application is itself in English and a translation into English is not required); an authorization to charge any additional fees to counsel's Deposit Account No. 12-0425; and a preliminary amendment. This submission was identified by applicants as having attorney docket number U 011573-2. It was placed by the USPTO in the '219 application. Both of the submissions filed 19 December 1997 appear to have been in the same envelope as both are identified by the same "Express Mail" mailing number-- EI528037962US. The "translation" provided with this submission does not appear to be identical to the international application or to either of the "translations" mentioned above.

On 08 October 1998, applicants filed a "REQUEST FOR NATIONAL PHASE ENTRY" including copies of the transmittal letter filed 18 December 1997, a postcard receipt, and a declaration of the inventors. This submission was not identified with an application number but did identify the attorney docket number as U 011574-0.

On 22 February 1999, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) in the '219 application indicating, *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) were required.

On 08 March 1999, the USPTO mailed a NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 (Form PCT/DO/EO/903) according the '219 application 35 USC 102(e) and 371 dates of 08 October 1998.

On 17 March 1999, applicants filed the present petition requesting that the '219 application be converted from an application filed under 35 U.S.C. 371 to one filed under 35 U.S.C. 111. The petition was accompanied by an authorization to charge \$130.00 for the requisite petition fee.

DISCUSSION

As noted above, in addition to the '219 application, applicants also filed on 18 December 1997, an additional set of application papers (Atty. Docket No. U 011574-0) for entry into the national stage for the above-captioned international application which has been accorded U.S. Serial No. 08/981,360. Both sets of application papers, however, were ultimately placed in the '219 application, along with applicants' submission of 08 October 1998.

35 U.S.C. 363 states:

An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in 102(e) of this title. (emphasis added)

Further, 35 U.S.C. 371(b) states:

(b) Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22(1) or (2), or under article 39(1)(a) of the treaty. (emphasis added)

The language of 35 U.S.C. 363 and 371 refers to the national stage of the PCT in the singular only, and thus only one (1) national stage application in the U.S. may develop from an international application. In that only one national stage of a PCT application is permitted, the filing of one of either the '219 application or the '360 application was improper. Therefore, conversion of one of these applications to one filed under 35 U.S.C. 111 is warranted. Although applicant requests conversion of the '219 application, it is more appropriate to convert the '360 application since the '219 application has already undergone a substantial amount of processing under 35 U.S.C. 371. The '360 application will be accorded a filing date of 18 December 1997, since the application papers as originally filed met the 35 U.S.C. 111 requirements for a specification, at least one claim, and the naming of the inventors.

As noted above, in all of applicants' submissions, both a copy of the international application and a "translation" of the international application were provided. The copy of the

international application will be used as the specification for the '219 application because the '219 application has been treated as the national stage application.

It should be noted that applicants are entitled in the '360 application to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since the '360 application and the international application were co-pending on 18 December 1997. In order to obtain benefit of the earlier international application, applicants must amend the beginning of the specification of this application by inserting a proper reference to the parent international application. Note that the reference to the international application made in the preliminary amendment filed 17 March 1999 is improper in that the '219 application has been treated as being filed under 35 U.S.C. 371 and thus cannot be a divisional.

As noted above, the declaration of the inventors filed 08 October 1998 having attorney docket number U 011573-2 was placed in the '219 application. Based on this placement, the USPTO incorrectly mailed a NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 (Form PCT/DO/EO/903) on 03 March 1999 indicating that the '219 application had been accorded 35 USC 102(e) and 371(c) dates of 08 October 1998. Deposit account 12-0425 was then charged \$130.00 for the surcharge for filing the declaration later than 30 months from the priority date and \$440.00 for claims in excess of twenty (as of 03 March 1999, there were a total of forty claims and the fee for each claim in excess of 20 was \$22.00).

In accordance with this decision, the declaration filed 08 October 1998 was removed from the '219 application and placed in the '360 application. Consequently, a declaration under 37 CFR 1.497(a)-(b) is required in the '219 application.

Note that a new declaration is required for the '360 application as well since it is not clear which specification the applicants executed. The declaration is directed to the specification which "was described and claimed in PCT International Application No. PCT/FI96/00359 filed on 20 June 1996". Since applicants filed both a copy of the international application and a "translation" which is not identical to the copy of the international application, it is unclear which specification the declaration is directed to.

The papers filed 19 December 1997 and identified by docket number U 011573-2 will remain in the '219 application and will be treated after applicants provide clarification. It is noted, however, that only one (1) national stage application in the U.S. may develop from an international application. It is possible that applicants intend this submission as yet another submission under 35 U.S.C. 111(a). If that is the case, a petition under 37 CFR 1.182 to remove the specification and to treat the specification as a filing under 35 USC 111(a) accompanied by the basic filing fee will be required. Clarification is also required concerning which of the two specifications submitted identified by docket number U 011573-2 (the copy of the international

application and the "translation") is intended as the specification to be used.

Fees

Application number 08/981,219

The following fees have already been paid:

- \$1,070.00 by for the basic national fee;
 - \$130.00 charged to deposit account 12-0425 for the surcharge for filing the declaration later than 30 months from the priority date;
 - \$440.00 charged to deposit account 12-0425 for claims in excess of twenty.
- An additional \$130.00 has been charged to deposit account 12-0425 for the petition filed 17 March 1999.

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Applicants have paid \$1070.00 by check for the basic national fee. Because this application is being converted to an application under 35 U.S.C. 111(a), the basic national fee is no longer due. However, the following fees are due: \$690.00 for the basic filing fee; and \$360.00 for claims in excess of twenty. The balance of \$20.00 has been refunded to deposit account 12-0425.

CONCLUSION

For the reasons above, the petition is GRANTED.

The NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 mailed 08 March 1999 in application number 08/981,219 is hereby VACATED.

Application number 08/981,219 will be the national stage of PCT/FI96/00359. However, the requirements under 35 U.S.C. 371(c) have not yet been satisfied. Applicants are required to (1) file an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and (2) clarify what is intended with the submission filed 19 December 1997 having docket number U 011573-2 within a time limit of ONE (1) MONTH from the date of mailing of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper reply will result in abandonment of the application.

The papers filed on 18 December 1997 and 08 October 1998 have been removed from the present application file and placed in US application number 08/981,360. Applicants are required to (1) file a new oath or declaration in compliance with 37 CFR 1.63 and (2) identify which of the two specifications filed on 18 December 1997 is to be used as the specification for application number 08/981,360 within a time limit of ONE (1) MONTH from the date of mailing of this

decision. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper reply will result in abandonment of the application.

A copy of this decision has been placed in application 08/981,360.



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